

REMARKS

Applicants have amended claims 1, 9, 14, 19, 24, 25, 28, and 35 to more appropriately define the present invention. Upon entry of this Amendment, claims 1-35 remain pending, with claims 1-28 and 35 under current examination, and claims 29-34 withdrawn from consideration as drawn to a nonelected invention.

Regarding the Office Action:

In the Office Action,¹ the Examiner rejected claims 1-28 and 35 under 35 U.S.C. § 102(b) as being anticipated by Satoru et al. (Japanese Publication 06-244091) ("Satoru"). Applicants traverse the rejection for the reasons set forth below.

Regarding the Claim Amendments:

Support for the claim amendments may be found in the drawings, at, for example, Figs. 1, 1B, 5F, 6, 9C, and 9F, and in their corresponding descriptions in the specification.

Rejection of Claims 1-28 and 35 under 35 U.S.C. § 102(b):

Applicants traverse the rejection of claims 1-28 and 35 under 35 U.S.C. § 102(b) as being anticipated by Satoru. Applicants respectfully disagree with the Examiner's arguments and conclusions.

In order to properly establish that Satoru anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim."

¹ The Office Action may contain statements characterizing the related art, case law, and claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Regarding Independent Claim 1:

Satoru does not disclose at least Applicants' claimed "a conducting member which is formed through the insulating film in a part of the region and which connects the conductive support and the conductive thin film electrically" (amended claim 1).

The Examiner alleges that Satoru discloses "a conducting member 12 which is formed through the insulating film 2 and which connects the conductive support 1f and the conductive thin film 3 electrically..." Office Action, p. 3. Applicants dispute the Examiner's characterization.

Rather, Satoru illustrates in Fig. 1 a stencil mask in which a tungsten film 12 is formed on a top and side surface, including a top and side surface of hole patterns 9A, 9B and 9C, of a silicon substrate 3. Further, in Fig. 2, Satoru illustrates that tungsten film 12 is formed additionally on a portion of a rear face 38 of a silicon substrate 3. This is clearly different from Applicants' claimed "conducting member." As recited in claim 1, the "conducting member" is formed in a *part* of the region, not on the *entire* surface of the silicon substrate 3, which is not the same as the formation of tungsten film 12 in Satoru.

Regarding Independent Claim 9:

Satoru does not disclose at least Applicants' claimed "a conductive support which is formed on the insulating film; a second opening which is formed through the conductive support and the insulating film in a part of the second region; and a conducting member which is provided in the second opening and which connects the conductive thin film and the conductive support electrically" (amended claim 9).

The Examiner alleges that Satoru discloses “a second opening 7 which is formed through the conductive support 1f and the insulating film 2; and a conducting member 12 which is provided in the second opening 7 and which connects the conductive thin film 3 and the conductive support 1f electrically...” Office Action, pp. 3-4. Applicants dispute the Examiner’s characterization.

Rather, Satoru’s region denoted by the reference numeral 7 in Figs. 1 and 2 corresponds to a first region recited in Applicants’ claim 9. Thus, Satoru does not disclose Applicants’ claimed “second opening formed through the conductive support and the insulating film in a part of the second region” (amended claim 9). Moreover, Satoru does not disclose that tungsten film 12 is formed *in* the second opening. Satoru’s tungsten film 12 is instead formed on a top surface of silicon substrate 3, side surfaces of openings 9A-9C, a bottom surface of silicon substrate 3, and the entire length of both side surfaces of a mask side surface 10. Thus, Satoru does not disclose Applicants’ claimed “conducting member which is provided in the second opening and which connects the conductive thin film and the conductive support electrically” (amended claim 9).

Regarding Independent Claim 14:

Satoru does not disclose at least Applicants’ claimed “a second opening formed in the conductive thin film and the insulating film in a part of the second region; and a conducting member which is formed in the second opening and which connects the conductive thin film and the conductive support electrically” (amended claim 14).

The Examiner alleges that Satoru discloses “a second opening 7 made in the conductive thin film 3 and the insulating film 2 in the second region of the conductive thin film; and a conducting member 12 which is formed in the second opening 7 and which connects the

conductive thin film 3 and the conductive support 1f electrically...” Office Action, p. 6.

Applicants dispute the Examiner’s characterization.

Rather, Satoru’s region denoted by the reference numeral 7 in Figs. 1 and 2 corresponds to a first region recited in Applicants’ claim 14. Thus, Satoru does not disclose Applicants’ claimed “second opening formed in the conductive thin film and the insulating film in a part of the second region” (amended claim 14). Moreover, Satoru does not disclose that tungsten film 12 is formed *in* the second opening. Satoru’s tungsten film 12 is instead formed on a top surface of silicon substrate 3, side surfaces of openings 9A-9C, a bottom surface of silicon substrate 3, and the entire length of both side surfaces of a mask side surface 10. Thus, Satoru does not disclose Applicants’ claimed “conducting member which is provided in the second opening and which connects the conductive thin film and the conductive support electrically” (amended claim 14).

Regarding Independent Claim 19:

Satoru does not disclose at least Applicants’ claimed “a second opening formed in the conductive thin film and the insulating film in a part of the second region; and a conducting member which is formed on the surface of the conductive thin film and in the second opening and which connects the conductive thin film and the conductive support electrically” (amended claim 19).

The Examiner alleges that Satoru discloses “a second opening 7 made in the conductive thin film 3 and the insulating film 2 in the second region of the conductive thin film; and a conducting member 12 which is formed on the surface of the conductive thin film 3 and in the second opening 7 and which connects the conductive thin film 3 and the conductive support 1f electrically...” Office Action, pp. 7-8. Applicants dispute the Examiner’s characterization.

Rather, Satoru's region denoted by the reference numeral 7 in Figs. 1 and 2 corresponds to a "first region" recited in Applicants' claim 19. Thus, Satoru does not disclose Applicants' claimed "second opening formed in the conductive thin film and the insulating film in a part of the second region" (amended claim 19). Moreover, Satoru does not disclose that tungsten film 12 is formed in the second opening. Satoru's tungsten film 12 is instead formed on a top surface of silicon substrate 3, side surfaces of openings 9A-9C, a bottom surface of silicon substrate 3, and the entire length of both side surfaces of a mask side surface 10. Thus, Satoru does not disclose Applicants' claimed "conducting member which is formed on the surface of the conductive thin film and in the second opening and which connects the conductive thin film and the conductive support electrically" (amended claim 19).

Regarding Independent Claim 24:

Satoru does not disclose at least Applicants' claimed "a conductive thin film having a first region and a second region, the second region being outside the first region ... an opening formed in the conductive support and a third region of the insulating film corresponding to a part of the second region; and a conducting member which is formed in the opening and which connects the conductive thin film and the conductive support electrically" (amended claim 24).

The Examiner alleges that Satoru discloses "an opening 7 made in the conductive support 1f and a region of the insulating film 2 corresponding to the second region of the conductive thin film 3; and a conducting member 12 which is formed in the opening 7 and which connects the conductive thin film 3 and the conductive support 1f electrically..." Office Action, p. 9. Applicants dispute the Examiner's characterization.

Rather, Satoru's region denoted by the reference numeral 7 in Figs. 1 and 2 corresponds to a first region recited in Applicants' claim 24, which does not constitute the claimed "second

region outside the first region” in which Satoru’s openings 9A-9C are formed. Thus, Satoru does not disclose Applicants’ claimed “a conductive thin film having a first region and a second region outside the first region ... [and] an opening formed in the conductive support and a third region of the insulating film corresponding to a part of the second region” (amended claim 24). Moreover, Satoru does not disclose that tungsten film 12 is formed *in* the second opening. Satoru’s tungsten film 12 is instead formed on a top surface of silicon substrate 3, side surfaces of openings 9A-9C, a bottom surface of silicon substrate 3, and the entire length of both side surfaces of a mask side surface 10. Thus, Satoru does not disclose Applicants’ claimed “conducting member which is formed in the opening and which connects the conductive thin film and the conductive support electrically” (amended claim 24).

Regarding Independent Claim 28:

Satoru does not disclose at least Applicants’ claimed “a conductive thin film having a first region and a second region, the second region being outside the first region ... an opening formed in the conductive thin film and the insulating film corresponding to a part of the second region; and a conducting member which is formed on the conductive thin film and in the opening and which connects the conductive thin film and the conductive support electrically” (amended claim 28).

The Examiner alleges that Satoru discloses “an opening 7 made in the conductive film 3 and a region of the insulating film 2 corresponding to the second region of the conductive thin film; and a conducting member 12 which is formed on the conductive thin film 3 and in the opening 7 and which connects the conductive thin film 3 and the conductive support 1f electronically...” Office Action, pp. 10-11. Applicants dispute the Examiner’s characterization.

Rather, Satoru's region denoted by the reference numeral 7 in Figs. 1 and 2 corresponds to a first region recited in Applicants' claim 28, which does not constitute the claimed "second region outside the first region" in which Satoru's openings 9A-9C are formed. Thus, Satoru does not disclose Applicants' claimed "a conductive thin film having a first region and a second region, the second region being outside the first region ... [and] an opening formed in the conductive thin film and the insulating film corresponding to a part of the second region" (amended claim 28). Moreover, Satoru does not disclose that tungsten film 12 is formed *in* the second opening. Satoru's tungsten film 12 is instead formed on a top surface of silicon substrate 3, side surfaces of openings 9A-9C, a bottom surface of silicon substrate 3, and the entire length of both side surfaces of a mask side surface 10. Thus, Satoru does not disclose Applicants' claimed "conducting member which is formed on the conductive thin film and in the opening and which connects the conductive thin film and the conductive support electrically" (amended claim 28).

Regarding Independent Claim 35:

Satoru does not disclose at least Applicants' claimed "a conductive thin film having a first region and a second region, the second region being outside the first region ... an opening formed in the conductive thin film corresponding to a part of the second region and the insulating film; and a conductive member which is formed in the opening and which connects the conductive thin film and the conductive support electrically" (amended claim 35).

The Examiner alleges that Satoru discloses "an opening 7 formed in the conductive thin film 3 corresponding to the second region and the insulating film 2; and a conductive member 12 which is formed in the opening 7 and which connects the conductive thin film 3 and the

conductive support 1f electrically...” Office Action, pp. 11-12. Applicants dispute the Examiner’s characterization.

Rather, Satoru’s region denoted by the reference numeral 7 in Figs. 1 and 2 corresponds to a first region recited in Applicants’ claim 35, which does not constitute the claimed “second region outside the first region” in which Satoru’s openings 9A-9C are formed. Thus, Satoru does not disclose Applicants’ claimed “a conductive thin film having a first region and a second region outside the first region ... [and] an opening formed in the conductive thin film corresponding to a part of the second region and the insulating film” (amended claim 35). Moreover, Satoru does not disclose that tungsten film 12 is formed in the second opening. Satoru’s tungsten film 12 is instead formed on a top surface of silicon substrate 3, side surfaces of openings 9A-9C, a bottom surface of silicon substrate 3, and the entire length of both side surfaces of a mask side surface 10. Thus, Satoru does not disclose Applicants’ claimed “conductive member which is formed in the opening and which connects the conductive thin film and the conductive support electrically” (amended claim 35).

Therefore, the Examiner has not established a *prima facie* case of anticipation. Independent claims 1, 9, 14, 19, 24, 28, and 35 are therefore allowable, for at least the reasons argued above, and dependent claims 2-8, 10-13, 15-18, 20-23, and 25-27 are also allowable at least by virtue of their respective dependence from allowable base claim 1, 9, 14, 19, 24, or 28. Therefore, the 35 U.S.C. § 102(b) rejection should be withdrawn.

Conclusion:

In view of the foregoing, Applicants request reconsideration of the application and withdrawal of the rejections. Pending claims 1-28 and 35 are in condition for allowance, and Applicants request a favorable action.

If there are any remaining issues or misunderstandings, Applicants request the Examiner telephone the undersigned representative to discuss them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 26, 2006

By: 

David M. Longo
Reg. No. 53,235

/direct telephone: (202) 408-4489/